

## **REMARKS**

Claims 1-42 are pending in the present application. The Examiner objected to an informality in the specification. In addition, claims 1-9, 11, 18-20, 22-25, 27-35, and 37 were rejected under 35 U.S.C. §102, and claims 10, 12-17, 21, 26, 36, and 38-42 were rejected under 35 U.S.C. §103. Applicant has amended to specification to correct the informality. No new matter has been introduced.

### **Specification Objection**

Applicant has amended the paragraph on page 17, beginning at line 6 (paragraph [0039], the second full paragraph on that page) so that “web server 114” now reads as “web server 112”. Applicant is puzzled by the Examiner’s reference to paragraph [0043], the second full paragraph on page 18, as that paragraph contains no reference to a web server. Reconsideration and withdrawal of this objection are respectfully requested.

### **Section 102 Rejections**

Claims 1-9, 11, 18-20, 22-25, 27-35, and 37 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,073,168 (Mighdoll, *et al.*).

Applicant respectfully traverses these rejections.

In order for a reference to anticipate under section 102, it must disclose, either explicitly, or under the principle of inherency, every claimed limitation of the claimed invention.

Claim 1 recites a method for filtering markup language documents that includes, *inter alia*, the steps of “constructing an input Document Object Model (DOM) based on a document, . . . , identifying elements of the input DOM that have previously been stored; and filtering the input DOM to obtain a filtered DOM . . .”.

Claim 28 recites a system for filtering markup language documents that includes, *inter alia*, “a filter . . . adapted to build an input document object model (DOM) based on the document, and filter the input DOM to output a filtered DOM . . .”.

Claim 29 recites a system for filtering markup language documents that includes, *inter alia*, “an intermediary . . . adapted to . . . receive a document . . . and to output a filtered document object model (DOM) . . . ; a storage device . . . adapted to store an input DOM, and identify elements of the input DOM that have previously been stored; and a filter . . . adapted to build the input DOM based on the document, and filter the input DOM to obtain the filtered DOM . . .”.

Applicant notes that the document object model (DOM) is a programming interface for documents formulated by the World Wide Web Consortium. It specifies a tree-like logical structure for documents and identifies the interfaces and objects used to represent and manipulate a document, the semantics of these interfaces and objects, including both behavior and attributes, and the relationships and collaborations among these interfaces and objects.

The Examiner cited Mighdoll as disclosing constructing an input Document Object Model (DOM) based on a document, a filter adapted to build an input document object (DOM) model based on a document, and an intermediary adapted to receive a document and to output a filtered document object model (DOM).

Applicant respectfully disagrees.

Mighdoll discloses a method for reducing delivery latency of a document over the World Wide Web. Mighdoll provides proxy cache for storing web documents and images requested from a web server, and a document database that stores diagnostic and historical information about documents retrieved from the server. Upon receiving a document request, Mighdoll’s server accesses the document database to determine if the document is valid, and if valid, the server retrieves the document from the cache. Otherwise, the server retrieves the document from a remote server. Mighdoll’s cache stores the full document, and if the cached

document is determined to be invalid, a full document is retrieved from the remote server. Although Mighdoll discloses storing information on a document in the document database, there is no disclosure in Mighdoll of “constructing an input Document Object Model (DOM) based on a document” or of a filter or storage device “adapted to build an input document object model (DOM) based on the document”. Further, although Mighdoll discloses transcoding a document to rewrite portions of the document, there is no disclosure of “filtering the input DOM to obtain a filtered DOM”. Since, as stated above, a DOM has a specified structure, a mere recitation of document information such as disclosed in Mighdoll is insufficient to disclose forming a DOM of a document. Further, the information stored in the document database is not used to filter the document, but to determine whether the server receiving the document request needs to retrieve an updated document from the remote server.

Since Mighdoll does not disclose, either explicitly or inherently, the claim 1 limitations of “constructing an input Document Object Model (DOM) based on a document” or “identifying elements of the input DOM that have previously been stored; and filtering the input DOM to obtain a filtered DOM”, Mighdoll does not anticipate claim 1. Since Mighdoll does not disclose, either explicitly or inherently, the claim 28 limitation of “a filter . . . adapted to build an input document object model (DOM) based on the document, and filter the input DOM to output a filtered DOM . . .”, Mighdoll does not anticipate claim 28. Similarly, since Mighdoll does not disclose, either explicitly or inherently, the claim 29 limitations of “an intermediary . . . adapted to . . . receive a document . . . and to output a filtered document object model (DOM) . . . ; a storage device . . . adapted to store an input DOM, and identify elements of the input DOM that have previously been stored; and a filter . . . adapted to build the input DOM based on the document, and filter the input DOM to obtain the filtered DOM . . .”, Mighdoll does not anticipate claim 29. Reconsideration and withdrawal of these rejections are respectfully requested.

Claims 2-9, 11, 18-20, 22-25, 27, 30-35, and 37 all depend from claims 1 or 29, and are thus patentable for at least the same reasons as claims 1 and 29. Reconsideration and withdrawal of these rejections are respectfully requested.

### **Section 103 Rejections**

Claims 10, 12, and 36 were rejected under 35 U.S.C. §103 as being obvious over Mighdoll in view of published U.S. Patent Application 2002/0065658 (Kanevsky, *et al.*). Claims 10 and 12 depend from claim 1, and claim 36 depends from claim 29. Kanevsky was cited for disclosing a system that provides web page content to users with special needs, such as those who are hearing impaired or blind. However, as stated above, Mighdoll does not disclose “constructing an input Document Object Model (DOM) based on a document”, as claimed in claim 1, or “an intermediary . . . adapted to . . . receive a document . . . and to output a filtered document object model (DOM)”, as claimed in claim 29, and Kanevsky does not remedy these defects in Mighdoll. Thus, Applicant urges that a *prima facie* case of obviousness of claims 10, 12 and 36 over Mighdoll and Kanevsky cannot be maintained. Reconsideration and withdrawal of these rejections are respectfully requested.

Claims 13-17 and 26 were rejected under 35 U.S.C. §103 as being obvious over Mighdoll in view of U.S. Patent No. 6,510,458 (Berstis, *et al.*). Claim 16 was further rejected in view of the Examiner’s Official Notice. Claims 13 and 26 depend from claim 1, and claims 14-17 all depend from claim 13. Regarding claim 13, Berstis was cited for disclosing inserting a first identifier in the filtered DOM to indicate a filtered status. Regarding claim 26, Berstis was cited for disclosing filtering being performed by a client device.

Section 103(c) states that “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or

subject to an obligation of assignment to the same person.” Applicant notes that Berstis is assigned to International Business Machines Corporation, the assignee of the present application. In addition, Berstis was filed on July 15, 1999, prior to the filing date of the present application, and issued on January 21, 2003. Thus, Berstis can only be prior art under section 102(e). Thus, under section 103(c), Berstis is not a valid reference against claims 13-17 and 26. As conceded in the Action, Mighdoll does not disclose the step of “inserting a first identifier in the filtered DOM to indicate a filtered status”, as claimed in claim 13, or a network environment in which “said filtering step is performed by the client device”, as claimed in claim 26. Thus, Applicant urges that a *prima facie* case of obviousness of claims 13 and 26 over Mighdoll cannot be maintained. Claims 14-17 depend from claim 13, and are thus patentable for at least the same reason as claim 13. Reconsideration and withdrawal of these rejections are respectfully requested.

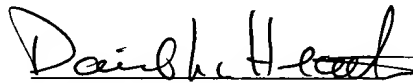
Claims 21 and 38-42 were rejected under 35 U.S.C. §103 as being obvious over Mighdoll in view of published U.S. Patent Application. 2002/0194388 (Boloker, *et al*). Applicant notes that the Examiner also refers to Berstis in rejecting claims 39-42, without having specifically cited it in paragraph 55 of the Action. Claim 21 depends from claim 1, and claims 38-42 depend from claim 29. Regarding claim 21, Boloker was cited for disclosing documents “wherein the markup language is extensible Markup Language (XML)”, which was not disclosed in Mighdoll. Regarding claim 38, Boloker was cited for disclosing a system “wherein the at least one page comprises at least one XML page”, and “transcoding the at least one XML page . . . in a multi-channel application or . . . transcoding the at least one XML page . . . in a multi-modal mode”, neither of which is disclosed in Mighdoll. Regarding claims 39-41, Boloker was cited for disclosing a system wherein “the input DOM [is] in a multi-channel mode”, “the input DOM [is] in a multi-modal mode”, and “the input DOM [is] in a channel/modality independent mode”, none of which are disclosed in Mighdoll and Berstis. Regarding claim 42, Boloker was cited for disclosing the system wherein “the filtered DOM includes . . . Voice extensible Markup Language (VoiceXML)”, which was not disclosed in Mighdoll and Berstis.

Applicant notes that Boloker is assigned to International Business Machines Corporation, the assignee of the present application. This assignment was recorded on July 15, 2002 (reel 013093, frame 0432). Boloker claims a priority date of December 4, 2000, before then filing of the present application, and was published on December 19, 2002. Thus, Boloker can only be prior art under section 102(e). Thus, under section 103(c), Boloker is not a valid reference against claims 21 and 38-42. Since, as stated above, Mighdoll alone does not disclose the limitations of claims 21 and 38, Applicant urges that a *prima facie* case of obviousness of claims 21 and 38 over Mighdoll cannot be maintained. Similarly, since Mighdoll and Bertis do not disclose the limitations of claims 39 to 42, a *prima facie* case of obviousness of claims 39-42 over Mighdoll and Bertis cannot be maintained. Reconsideration and withdrawal of these rejections are respectfully requested.

**CONCLUSION**

Applicant urges that claims 1-42 are in condition for allowance for at least the reasons stated. Early and favorable action on this case is respectfully requested.

Respectfully submitted,

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